

**REMARKS**

In view of the following remarks, the applicant respectfully requests reconsideration and further examination of the instant application.

**Claim Rejections - 35 U.S.C. 112**

Claims 1-23 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The Action states that terms "token," "probabilistically," and "pledge" are not defined in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention when the application was filed. For the reasons given below, the applicant respectfully disagrees.

It is respectfully submitted that each and every one of the objected terms have clear and defined meaning within the art. For example, according to Merriam-Webster Online Dictionary, "token," among other things, means "a symbol, an emblem, a small part representing the whole." According to the same Dictionary, one meaning of "probabilistic" comprises "of, relating to, or based on probability." In other words, the term "probabilistic" relates to a parameter that is based on, or affected by probability, randomness, or chance. Finally, the Merriam-Webster Online Dictionary defines "pledge," among other things, as "a binding promise or agreement to do or forbear."

Because the objected terms are well defined, it is submitted that the applicant has complied with the "written description" requirement of 35 USC 112, first paragraph.

**Claim Rejections - 35 U.S.C. 101**

Claims 10-13 stand rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

The Action states that the invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to technological art, environment or machine, the claim is not statutory. The Action however, has not provided any specific or reasons as to why claims 10-13 are deemed non-statutory.

Claim 10-13 recites a method for transferring ownership of assets to participants over a network, wherein the participants interface with the network using wired or wireless devices. The applicant respectfully submits that the claims are directed to statutory subject matter because the preambles of claims 10-13 recite the technological art, environment or machine in terms of a network, where the asset ownership is transferred, as well as in terms of wired or wireless devices that are used for interface between the participants.

#### **Claim Rejections - 35 U.S.C. 103**

Claims 1-23 stand rejected under 35 USC 103(a) as being obvious over US Patent No. 5,537,314 A issued to Kanter (Kanter).

In relevant sections, Kanter discloses a system that allows one or more sponsoring companies to offer awards to participants, if they satisfy minimum performance criterion, for example, after making a certain number of purchases. According to Kanter, the participants use one or more cards or account numbers to participate in such award programs as price discount, catalog merchandise, travel tour, cash, check, coupon, certificate or direct deposit into the participants' bank account. Also, the award could be a raffle entry or sweepstake entry, when the participants makes a sale or purchase that meets a minimum requirement.

Briefly, the claimed invention, as exemplified by the pending claim 1, covers transferring ownership of an asset over a network by issuing redeemable tokens that are associated with one or more participants and have defined redemption values. According to the claimed invention, at least one redeemable token is probabilistically selected, when the redemption value of the issued redeemable tokens reaches a collective token value which can be predetermined by the sponsoring company, which could for example be equal to a specified redemption value for the asset, as required by claims 2 and 3. The present invention

transfers ownership rights in the asset to a participant who is associated with a selected redeemable token.

It is well settled that a single prior art, such as Kanter, can be modified to establish a prima facie case of obviousness, provided that the Action sets forth (1) the relevant teachings of the prior art relied upon, preferably with references to the relevant column or page number(s) and line number(s) where appropriate, (2) the difference or differences in the claim over the applied reference, (3) the proposed modification of the applied reference necessary to arrive at the claimed subject matter, and (4) an explanation why such proposed modification would have been obvious to one of ordinary skill in the art at the time the invention was made. See M.P.E.P. §706.02(j).

Without pointing out the relevant sections of the relied upon prior art, as required by MPEP, the Action summarily states that Kanter discloses all of "the methods, steps and means described within claims 1-23," except that Kanter uses the term "award" instead of the "token" recited in the claims. As best understood, the Action argues that it would have been obvious to use the "awards" of Kanter instead of the claimed "tokens". For the reasons set forth below, the applicant respectfully disagrees.

The applicant is at a loss as to why the claims are rejected based on focus on "award," when the invention as a whole involves transfer of ownership in assets, as recited both in the Title of the instant application as well as in all claim preambles. The applicant agrees that the history of mankind is replete with instances of incentivized action in exchange for asset ownership. The applicant respectfully submits, however, that the claimed invention is an asset ownership transfer vehicle and not an award program. In fact, the award system of Kanter could be complemented by an asset transfer, according to the present invention. However, equating "award" and "token" as suggested by the Action has no relevance as to whether the present invention is patentable over Kanter. Simply put an award program is an asset transfer. In other words, an asset, e.g., tokens, transferred according to the present invention can be used in the award program of Kanter.

It is submitted that despite the summary assertion that Kanter teaches "all of the methods, steps and means described within claims 1-23," the Action fails to establish a prima

facie case of obviousness because it does not point to any teaching or suggestions in Kantor for each and every one of the expressly required claimed limitations. For example, the Action has not identified where in Kantor there is a teaching or suggestion regarding the issuance of redeemable tokens having predefined redemption values. Moreover, the Action has not pointed to any teachings or suggestions relating to such tokens being subject to probabilistic selection in order to transfer asset ownership.

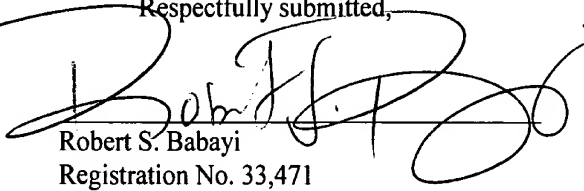
The Action merely argues that it would have been obvious to use the claimed "token" of the invention as an "award" in Kantor because it would motivate action. It is unknown, however, how or why the Action has made the leap for the "award" of Kantor being considered as a redeemable token for asset ownership transfer. Based on customary and ordinary dictionary meanings set forth above, for example, the applicant respectfully submits that the claimed "token" is a symbol that represents a predefined redeemable value. Even assuming, arguendo, that the "awards" of Kantor could be construed as a "token," the Action has not pointed to any teaching or suggestion for such award having redeemable predefined value associated with a participant, as required by the claimed invention.

Another claim limitation requires probabilistically selecting at least one redeemable token, when redemption value of the issued redeemable tokens reaches a collective token value predetermined by the sponsoring company, which may own the asset or may be acting as an intermediary between buyer and seller. The Action has not identified where in Kantor this required condition for the probabilistic selection of a redeemable token is taught or suggested. Finally, the claim requires transferring an ownership right to at least one asset to a participant who is associated with a selected redeemable token. Again, the Action has not identified where in Kantor there is a teaching or suggestion for an asset ownership transfer based on the probabilistic token selection required by the claimed invention.

In view of the above remarks, the applicant submits that Claims 1-23 meet all patentability requirements. If, for any reasons, further communication would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Applicants: Pellegrini  
Application No. 09/736,134

Applicant believes there are no additional fees associated with this reply other than those indicated. However, if this is incorrect, the Commissioner is authorized to charge any fees which may be required for this paper to Deposit Account No. 22-0261

Respectfully submitted,  
Date: 6/3/04  
  
Robert S. Babayi  
Registration No. 33,471  
VENABLE  
P.O. Box 34385  
Washington, D.C. 20043-9998  
Telephone: (202) 344-4800  
Telefax : (202) 344-8300

RSB/klm  
#546849